

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re the Application of: Karen Axelsson	Atty. Docket No.: 006917.00009
Serial No.: 09/891,379	Group Art Unit: 2617
Filed: June 27, 2001	Examiner: Usha Raman
For: EPG Having PIP Window History And Sample View Functionality	Confirmation No.: 2564

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

**Box Appeal Briefs - Patents**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-14501

Sir:

Applicants respectfully request review of the final rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a Notice of Appeal. The review is requested for the reasons stated in the below remarks. If any fees are required or if an overpayment is made, the Commissioner is authorized to debit or credit our Deposit Account No. 19-0733, accordingly.

***Remarks***

Having received and reviewed the final Office Action dated December 19, 2005, Applicants respectfully submit that the standing rejections are based on one or more clear errors, and that the appeal process can be avoided through a pre-appeal brief review as set forth in the Official Gazette notice of July 12, 2005.

The specific errors relied upon in this Pre-Appeal Brief Request for Review include the following:

- The pending 35 U.S.C. §102 and §103 rejections fail to address all the claim limitations, and
- The combination of references asserted in the pending 35 U.S.C. §103 rejection fail to disclose the subject matter of the rejected claims.

**A. The Examiner Has Not Addressed All Claim Limitations**

Claims 1-7, 10, 13, 22-28 and 33-34 are rejected under 35 U.S.C. § 102(b) as being anticipated by PCT International Publication No. WO 97/34414 to Yuen et al., (“Yuen”). Yuen is directed to a feature for an electronic program guide (EPG) that “provides the viewer [a] means for returning from the guide mode to a last channel displayed full screen in a television viewing mode, or last channel full screen (LCF), prior to entering the guide mode.” (Page 2, Summary of the Invention, line 8; emphasis added). In fact, Figure 1 and the corresponding disclosure on page 4 cited by the Office Action disclose a television receiver having an EPG, wherein the novelty over prior art is “the addition of a last channel register 34.” (Page 4, lines 27). Indeed, as explicitly provided by Yuen “[w]hile the system is in the guide mode, the data in last channel register 34 does not change.” (Page 6, lines 13 – 4). For these and reasons discussed below, there are several claim limitations of the rejected claims that are not met or otherwise suggested by Yuen.

1. No teaching of “addition of parameters identifying the additionally selected programs to a list of selected programs stored in the storage means”

As discussed above, the last channel recall of Yuen is not updated or stored while in the “PIP mode” / “guide mode” of Yuen’s EPG. Therefore, there can be no “addition of parameters identifying the additionally selected programs to a list of selected programs stored in the storage means”. Rather, the cited text only allows the user to “select[] a particular program from the displayed current television program listings by a means of a cursor or a code number, [wherein] the corresponding program automatically appears in the PIP window. In this way, the viewer can channel graze by sequentially selecting the individual program listings in the background.” (Page 3, lines 29 – 32). The viewer simply sequentially grazes channels, until he or she locates a desired program, and leaves the PIP mode to watch the desired program. There is no teaching or suggestion of storing the parameters of additionally selected programs during the browsing to a list. Indeed, the specification and substitute specification of the present invention reiterated the drawbacks of Yuen by noting “if a user has displayed several programs in the PIP area, the user may only revert back to the last channel viewed in full screen.” (Sub. Spec.; Page 2, paragraph 0006). Its either view the last channel viewed before entering the guide or the program currently selected, there is no list of selected programs stored in a storage means.

These limitations are not taught, disclosed, or otherwise suggested by the remaining art of record, therefore, the Applicants respectfully request reversal of the rejection.

2. No teaching of “third display generation means...”

In the presently rejected claims, the selected program is selected from the electronic program guide and displayed in a second display area, such as a picture-in-picture window, of the display and as discussed above, the “addition of parameters identifying the additionally selected programs to a list of selected programs stored in the storage means” Claim 4, for example, further recites the limitation of a “third display generation means for generating display of a list of the selected programs stored in the storage means in a third display area of the display unit.” (see also, *inter alia*, claims 6, and 23 – 27; further elaborated on in paragraph 8 of the Substitute specification).

The Examiner asserts that unit 45 of Fig.2 of Yuen shows this limitation. (Office Action dated December 19, 2005; page 4). Unit 45 of Fig. 2, however, is merely one of the listings within the Electronic Programming Guide (asserted by the Examiner to be the second display area) that lists the last channel viewed prior to entering the SURF guide. As set forth in Yuen, “[i]n order to utilize the last channel feature, the viewer must return to the SURF guide and select last channel listing 45 with cursor 48 prior to exiting the guide mode. (Page 7, lines 10 – 11). There is no teaching of a third display generation means as claimed in the rejected claims, therefore, the Applicants respectfully request reversal of the rejection.

3. No teaching of “display of the selected program in the second display area of the display unit for a predetermined time...”

Claims 8-9, 11, 15-18, 20 and 29-32 are rejected under 35 U.S.C. § 103(a) as being unpatentable over PCT International Publication No. WO 97/34414 to Yuen et al., (“Yuen”) in view of U.S. Publication No. 2002/0152459 to Bates et al., (“Bates”).

Bates is directed to recalling a channel of interest, wherein the “channel of interest is determined by the amount of time a user has previously spent on the channel.” (Abstract). This is entirely different than the subject matter of claims 8-9, 11, 15-18, 20 and 29-32 and any claims from which they depend. Indeed, as recited in exemplary claim 8:

[a] timer means, wherein said timer means is activated upon program selection and causes setting and display of the selected program in the second display area of the display unit for a predetermined time and renewed setting and display of the previously selected program in the second display area of the display unit upon elapse of the predetermined time

(Claim 8; *see also*, Claims 9, 15, and 29). Indeed, as claimed, a selected program is displayed in a second display for a predetermined time period (i.e. 5 – 15 seconds), then will automatically revert back (“upon relapse”) to an earlier program displayed in the second display. Indeed, even the Office Action acknowledges that Bates requires a “viewer [to] activate the selective view function which returns him to the last channel of interest.” (Office Action dated 12/19/05; page 10). Moreover, while Bates discusses the use of information from an ESG to, for example, to determine when a program has ended, there appears to be no discussion of displaying the selected program in a second display for a predetermined period as recited in the rejected claims. These limitations are not taught, disclosed, or otherwise suggested by the remaining art of record, therefore, the Applicants respectfully request reversal of the rejection.

#### **B. Combining the References Does Not Produce the Claimed Subject Matter**

As discussed above, Yuen does not disclose, teach, or otherwise suggest the subject matter of numerous limitations. These limitations are not met, either individually or in combination, with Darbee or Bates. While Darbee is directed to a program guide on a remote control display, there is no teaching or suggestion of the limitations of independent claim 1, from which claims 12 and 14 depend or of claim 15, from which claims 19 and 21 depend.

Moreover, as discussed above, Bates is directed to recalling a channel of interest, wherein the “channel of interest is determined by the amount of time a user has previously spent on the channel.” Even combining these references with Yuen, the subject matter of the rejected claims is not taught, disclosed, or otherwise suggestion. Therefore, in view of the foregoing, the Applicants respectfully request reversal of the 35 U.S.C §103 rejection.

While Applicants believe the above points represent the clearest errors made by the Office, Applicants reserve the right to appeal on other bases and errors. In addition, Applicants believe the rejections of other claims not identified above are also based on one or more Office errors.

Applicants will address such issues on appeal should the appeal of this case proceed after the Office's consideration of this paper.


**CONCLUSION**

All issues having been addressed, Applicants respectfully submit that the instant application is in condition for allowance, and respectfully solicit prompt notification of the same. However, if for any reason the review panel believes the application is not in condition for allowance or there are any questions, the review panel is invited to contact the undersigned at (312) 463-5434.

Respectfully submitted,

BANNER & WITCOFF, LTD.

Dated this 6<sup>th</sup> day of April, 2006

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